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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,705	03/17/2000	Robert A. Luciano	732.083	3145

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EXAMINER

MARKS, CHRISTINA M

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/527,705

Applicant(s)

LUCIANO, ROBERT A. *Ch*

Examiner

C. Marks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 29 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 9, 10, 12-14, 19-40, 45-50, 52, 54, 56, 65, 66, 70, 74, 76 and 77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9, 10, 12-14, 19-40, 45-50, 52, 54, 56, 65, 66, 70, 74, 76 and 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

The corrected or substitute drawings were received on 09 October 2002. These drawings are acceptable.

The objections to the drawings have hereby been withdrawn due to the corrections in the drawing files on 09 October 2002.

Specification

The objection to the specification is hereby withdrawn due to the amendment filed on 28 January 2003. Regarding the incorporation by reference to essential material, Applicant admitted in amendment that the material incorporated is not believed to be essential.

Furthermore, the typographical errors as well as the length of the abstract have been corrected.

Claim Objections

Claims 49 and 70 are objected to because of the following informalities: Claim 49 depends on cancelled claim 44 and Claim 70 depends on cancelled claim 68. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The rejection to claim 1 under the second paragraph of 35 U.S.C. 112 is hereby withdrawn due to the amendment files on 28 January 2003.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 9, 10, 12-14, 19-36, 50, 52, 54, 56, 65, 66, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff (US Patent No. 6,224,483) in view of Stanley (GB 2,320,206) further in view of Crawford et al. (US Patent No. 6,270,412).

Mayeroff et al. disclose a gaming apparatus to play games of chance wherein the apparatus consists of a first housing portion housing a spinning reel first game of chance (FIG 2, reference 110) with an outcome display, an award display (FIG 1, reference 40), a first game actuator (FIG 2, reference 138) that is activated for play by the game player. Furthermore, the apparatus consists of a second housing portion housing a spinning wheel second game of chance (FIG 2, reference 150) with a range of outcomes that can alter the award to the game player (Abstract) by providing an additional award. The second game of chance is mounted atop the first and is proximate and adjacent in an integral game frame with the first game of chance whereby the player can observe both games from one location (FIG 1) and the second game of chance has an outcome display and an actuator (FIG 2, reference 140) that is activated by the primary gaming unit has randomly selected one of a plurality of indicia sets (Column 5, lines 23-26). All spins of the rotating wheel bonus game are winning spins (Abstract, lines 14-15) therefore the wheel outcome includes an award to the game player.

Stanley teaches of an amusement apparatus that has a first type of game that upon a predetermined completion will initialize a second type of game and success on the second game will lead to a further game on the first game (Abstract). In the disclosed apparatus, the second game of chance can lead to an alteration of the result of the first game of chance (page 5, lines 21-23) by obtaining a predetermined alteration outcome as a result of the game, such as rotating the reels (FIG 4, reference 10, NUDGES) and changing the first game outcome in the first game

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outcome display and providing a chance-improving outcome as the reels can then be moved to a winning combination. Further another alteration of the first game outcome provided for by the second game would be to spin until a win is achieved (FIG 4, reference 10, SPIN A WIN). The second game of chance is connected to the first game and is activated upon predetermined completion of the first game (Abstract). Stanley discloses that upon success in the second game of chance, the first game of chance can again be replayed. Stanley also discloses an additional award can be won from the second game based upon a predetermined outcome (FIG 4, reference 10, win L3) thereby increasing the total award provided to the player. Though Stanley does not distinctly disclose that upon the first game of chance being played again, the second game of chance is again activated, this is strongly implied by Stanley in that the bonus game allows the play of the first game to again occur and thus it would be inherent that the same payable is used in the first game. Therefore, if the "nudges" or "spin until a win" are obtained from the bonus game in order to replay the first game result in a the predetermined completion associated with the bonus game, the bonus game would axiomatically be re-enacted.

(raise Abstract text)

Crawford teaches of a slot machine with a symbol save feature which allows a player to save in memory (and retrieve for later use in determining a winning combination) one or more symbols from one or more previous games and use those symbols in a current or future game to obtain a winning combination (Abstract, lines 3-5) and alter the likelihood of obtaining an award. The symbol save feature can be saved from a game of chance and transferred to another game of chance output display (Abstract, lines 6-8). This device is located on the gaming machine (FIG 5, reference 54).

Applicant notes that an ongoing motivation of the gaming industry is to develop slot type machines that are more exciting to play and thus more likely to be played and generate revenue. Stanley teaches of an amusement device where play is more exciting given the fact that the bonus round can alter the base round and there are such bonus awards as spin until a win and nudge. With these additional features, the bonus game would become much more exciting to the user as there is higher anticipation of a positive result from the bonus. By incorporating an apparatus that provides the user with a higher anticipation of an award and greater excitement, the lure of the machine is greatly increased and the goal of the gaming industry is met as the slot machine is more exciting to play and thus more likely to be played and generate revenues. For these reasons, it would have been obvious to one skilled in the art at the time of invention to incorporate the bonus round teachings of Stanley into the apparatus of Mayeroff to create a game of chance where the bonus round is more exciting and enticing to the user.

Further, as is well known in the art, when a user perceives a greater chance of winning on a gaming machine, the user is more likely to participate in play of that machine. By incorporating the symbol save feature of Crawford into the apparatus of Mayeroff in view of Stanley, the user would get even more enjoyment out of the bonus round as it would be possible to save a bonus features for use at a later time. Therefore, it would have been obvious to one skilled in the art at the time of invention to incorporate the teachings of Crawford into the apparatus of Mayeroff in view of Stanley to create a bank in which the user could store a symbol obtained in the bonus round for use in the primary round at a later time in order to give the user a feeling of better control over their own fate in the game, thus giving a perception of a greater likelihood of award winnings.

Regarding the method steps of claims 65, 66, and 70, Mayeroff teaches a method of a base game of chance used to procure a first base game outcome and upon the appearance of a predetermined outcome, a bonus opportunity is given (Abstract). Mayeroff also then teaches of actuating the bonus game of chance to procure a bonus game outcome and upon the appearance of a predetermined outcome, an award is given. Stanley teaches a method of once the bonus game is initialized, awarding the player to again play the base game of chance upon a certain combination (Abstract). Crawford teaches a method of using a bank portion for a bonus game to transfer the symbol to a base game of chance. Based upon the obviousness to combine these references and the motivation stated above, it would have been obvious to one of ordinary skill in the art to incorporate the method disclosures garnished from the teachings into the device as disclosed above.

Claims 37-40, 45-49, 74, 76, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff (US Patent No. 6,224,483) in view of Stanley (GB 2,320,206) further in view of Crawford et al. (US Patent No. 6,270,412) further in view of Kaku.

What Mayeroff, Stanley, and Crawford disclose, teach, and/or suggest has been discussed above and is incorporated herein.

Kaku et al. teaches of increasing user enjoyment by increasing the number of combinations that would produce a winning result (page 3, lines 11-14). To address this issue, the disclosed invention includes three donut-shaped disks that are in a concentric relation (page 4, lines 1-2) and have patterns of numbers, letters, or pictures (page 4, line 25). The disks are

rotated independently and are stopped separately (page 5, line 1-2), thus they spin sequentially. Moreover, the number of disks can be made two (page 8, line 15).

By replacing the wheel device of the bonus round with the concentric wheel device taught by Kaku et al., the user would enjoy the bonus round more as the number of winning combinations would appear to be or actually be increased. This would provide more excitement to the user than a solo rotating wheel as there would be more than one rotating factor involved in determining the result of the bonus round. Therefore, it would have been obvious to one skilled in the art at the time of invention to incorporate a different design choice as a means for presenting the bonus round. By incorporating the design choice taught by Kaku et al., the user would experience a greater sense of enjoyment from the bonus round as it would be more exciting when a plurality of spinning wheels are involved and a greater sense of a winning possibility is experienced.

Response to Arguments

Applicant's arguments filed 28 January 2003 have been fully considered but they are not persuasive.

In response to the Applicant's arguments that the Stanley reference provides no teaching of how to make and use such a feature, the Examiner respectfully disagrees with the position that the Stanley reference is non-enabling with respect to the bonus game and base game. One of ordinary skill in the art would understand how to make and use the Stanley reference as a gaming machine where the bonus round creates a chance to replay the base game.

In response to the Applicant's arguments that the Stanley in view of Mayeroff provides no teaching of a second game that displays on the second game outcome display an alteration of

said first game outcome procured or to be procured in a future play of said first game of chance upon the occurrence of at least a first game alteration outcome in said second game of chance, the Examiner respectfully disagrees. The second game outcome of Stanley (FIG 4) displays an alteration of a said first game outcome (FIG 4, references 10) based upon an occurrence of a first game alteration outcome in the second game (page 6, lines 10-11).

In response to the Applicant's argument that neither Stanley or Mayeroff provide a teaching wherein said range of second game chance outcome includes a first game playing outcome whereby said first game of chance may be played again, and wherein second game of chance is connected to said first game of chance so that the said second game of chance is activatable upon the occurrence of said or another predetermined event in said first game of chance, the Examiner respectfully disagrees. In the new ground of rejection discussed above, the Examiner stated: "Though Stanley does not distinctly disclose that upon the first game of chance being played again, the second game of chance is again activated, this is strongly implied by Stanley in that the bonus game allows the play of the first game to again occur and thus it would be inherent that the same payable is used in the first game. Therefore, if the "nudges" or "spin until a win" are obtained from the bonus game in order to replay the first game, result in a the predetermined completion associated with the bonus game, the bonus game would axiomatically be re-enacted." Hence, it is axiomatic to the gaming device of Stanley that such a feature is present.

In regard to Applicant's argument that neither Stanley nor Mayeroff teach of a second game wherein the range of second game chances outcomes includes a chance-improving outcome, the Examiner respectfully disagrees. The chance outcomes available in Stanley include

a Spin A Win (FIG 4), which thereby improves the player's future award as a spin until a win is guaranteed.

In response to the Applicant's argument that neither Stanley or Mayeroff teach of a game outcome linkage interconnecting said first and second games of chance to change a game outcome in the first game upon the appearance of at least one predetermined changing outcome in the second game, the Examiner respectfully disagrees. Stanley teaches a base game and a bonus game that are linked together. Upon a win on the first game, the second game is enacted (page 2, line 22). Thereby, the games are linked together. Furthermore, upon a result in the second game, a further spin on the first game can occur (Abstract). Thereby, the games are expressed linked; including an outcome linkage and the first game of chance can be changed by the second game of chance. Furthermore, in response to the Applicant's argument that neither Stanley nor Mayeroff teaches that when a predetermined changing outcome occurs again in the first game of chance, the second game of chance is then adapted to again actuate the second game of chance upon another predetermined first game outcome, the Examiner respectfully disagrees and notes this point is addressed in the response to arguments above.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *MPEP 2145 X*. In the instant case, it is well known in the art that creating bonus games that present the user with the sense that they

have a better chance of winning is a goal of the gaming industry. The teachings of Stanley disclose that a bonus game that is enacted by a base game can provide a further game on the base game to improve the chances of winning. The teachings of Crawford disclose that a symbol can be saved from a base game and then applied to a later or bonus game to improve the chances of winning. Both of these teachings are drawn towards improving the chance of winning in a bonus game for a user. These teachings constitute a motivation in that they provide an improved chance in a bonus game enacted by a base game, such as the disclosed of Mayeroff. One of ordinary skill in the art would be motivated henceforth to combine these teachings in order to provide features that will give the user a better sense of a winning possibility. Further motivation resides in the fact, that upon combination, users would be more enticed to play a game that they perceive having a better chance of earning winnings, thus creating a more prolonged play and increased revenue for the casino. Such a motivation is well known in the art and therefore creating combinations to reach the goal of increasing user enjoyment would be obvious to one of ordinary skill in the art.

In response to the Applicant's argument that the incorporation of the Kaku reference would not have been obvious to one of ordinary skill in the art, the Examiner respectfully disagrees. Concentric wheels are well known in the art and often used in the gaming environment. Kaku teaches of such a wheel and the motivation for using one. Kaku states that increased user enjoyment and anticipation is provided in the fact that the user can see all possible combinations. This is indeed motivation of the design choice to substitute such a wheel in place of the non-concentric wheel of Mayeroff. By increasing user excitement and anticipation and by using a wheel device that does such, it is known that a user will be more likely to use such a

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device and therefore be more inclined to play. Thus, more revenue would be earned and the casino would thereby be motivated to incorporate a concentric wheel as disclosed by Kaku as opposed to a plain wheel as disclosed by Mayeroff.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *MPEP 2143.01*. In this case, as outlined above, the features are all drawn towards improving the sense of the possibility for winning in a bonus game which is well known in the art to create more use by the players. Therefore, combination of such is proper because the combination of teachings are all drawn towards the same feature and the same goal for the same motivation of creating enhanced bonus games wherein the user will be more prone to playing.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *MPEP 2145 V*.

In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *MPEP 2145 VIII*.

In response to the Applicants argument that Mayeroff and Stanley do not teach a second game of chance outcome display connected to the first game of chance controller and including second game outcome indicia indication a second game award opportunity for the player to replay the first game of chance, the Examiner respectfully disagrees. Stanley teaches of a second game outcome display (FIG 4) that is enacted based upon a first game of chance event (Abstract) thus it is axiomatically connected to the first game of chance controller and the second game of chance includes a game outcome indicia indication of a second game award opportunity to replay the first game (FIG 4).

In response to the Applicant argument that Mayeroff and Stanley do not teach of a gaming device mounted in an integral frame, the Examiner respectfully disagrees. Mayeroff discloses both the bonus game and the base game as being in an integral frame (FIG 2).

Applicant's arguments with respect to claims 65-79 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Friday (7:30AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Martin-Wallace can be reached on (703)-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

cmm
cmm

February 10, 2003



MICHAEL O'NEILL
PRIMARY EXAMINER